IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE: FLATT, Jerrold V.	)
	) **APPEAL NO. _____**
SERIAL NO: 09/992,764	)
	)
FOR: SOFTWARE ARTICLE, SYSTEM AND METHOD FOR PHYSICIAN REFERRAL SERVICES	)) **BRIEF ON APPEAL**
	)
	)
FILED: November 6, 2001	)
	)
GROUP ART UNIT: 3626	)

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I. INTRODUCTION

This is an appeal of the Final Rejection dated November 6, 2006, finally rejecting claims 1-3, 5-18, 20-23, and 25. Appealed claims 1-3, 5-18, 20-23, and 25 are set forth in the attached Claim Appendix.

II. REAL PARTY IN INTEREST

The applicant is the real party in interest in this appeal.

III. RELATED APPEALS AND INTERFERENCES

None.

IV. STATUS OF CLAIMS

Claims 1-3, 5-18, 20-23, and 25 stand rejected under 35 U.S.C. § 103(a). Claims 1-3, 5-18, and 20-23 are rejected under § 103(a) as obvious over Filler in view of Bianco et al. and further in view of Kiselik. Claim 25 is rejected under § 103(a) as obvious over Filler in view of Bianco et al. All rejections are being appealed, and accordingly claims 1-3, 5-18, 20-23, and 25 are on appeal.

V. STATUS OF AMENDMENTS

No amendments were filed after final rejection.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed toward a method of managing patient referrals between health care providers. The method includes providing a web site accessible to a plurality of health care providers, receiving through the web site, a plurality of health care provider registrations each associated with a health care provider, receiving a request for a patient consultation from a first health care provider to be performed by a second health care

provider, both the first health care provider and the second health care provider having a health care provider registration, notifying the second health care provider of the request for a patient consultation according to a preferred mode of communication setting set by the second health care provider on the web site, and receiving a peer rating from the first health care provider of the second health care provider.

Independent claim 18 is directed toward a system for managing patient referrals. The method includes a web site accessible to a plurality of health care providers, at least one registration web page within the web site to allow each of the plurality of health care providers to register to become registered health care providers, an inbox within the web site associated with at least one of the registered health care providers and containing at least one request for a patient consult made to the at least one of the registered health care providers, an outbox within the web site associated with the at least one of the registered health care providers and containing at least one request for a patient consult made by the at least one of the registered health care providers, a peer review component for providing feedback related to a patient consult by a consulting health care provider from a referring health care provider, and a mode of communication preference set by a referring health care provider and provided to a consulting health care provider.

Independent claim 25 is also directed toward a method of managing patient referrals. The method includes providing a web site accessible to a plurality of health care providers, the plurality of health care providers including a referring physician and a consulting physician, receiving a request on the web site from the referring physician for a patient consultation to be performed by the consulting physician on a patient, notifying the consulting physician of the request for a patient consultation, requesting an authorization number for the patient consultation from an insurer providing insurance to the patient, wherein the step of notifying the consulting physician is notifying the consulting physician according to a preferred mode of communications setting set by the consulting physician on the web site.

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-3, 5-18, 20-23, and 25 were improperly rejected under 35 U.S.C. § 103(a) based in part on the Bianco et al. reference?

B. Whether claims 1-3, 5-18, and 20-23 were improperly rejected under 35 U.S.C. § 103(a) based in part on the Kiselik reference?

C. Whether claims 1-3, 5-18, 20-23, and 25 were improperly rejected under 35 U.S.C. § 103(a) based in part on the Filler reference?

VIII. ARGUMENT

A. Claims 1-3, 5-18, 20-23, and 25 were improperly rejected under 35 U.S.C. § 103(a) based on examiner's mischaracterization of the Bianco et al. reference

The examiner has rejected independent claims 1, 18, and 25 (and dependent claims 2-3, 5-17, and 20-23 depending therefrom) in part because Bianco et al. (US 2002/0082865) discloses the "preferred mode of communications" limitation in each of these independent claims. (*See* November 6, 2006 Office Action, pp. 5, 7, 12). In applicant's response, he pointed out that Bianco et al. does not disclose a consulting physician or system user to set a preferred mode of communication, but instead only discloses that "there are many different types of communication that can be used." (*See* July 26, 2006 Amendment, p. 8, *quoted in* November 6, 2006 Office Action, pp. 16-17). The examiner's assertion maintaining that Bianco's disclosure discloses the "preferred mode of communications" limitation is based on a strained reading of the reference inconsistent with the plain meaning of the claim element. (*See* November 6, 2006 Office Action, pp. 17-18). The examiner all but admits this by stating that the examiner's interpretation is contingent upon the examiner's perceived "flexibility of Bianco et al." (*See* November 6, 2006 Office Action, p. 18).

Specifically, the examiner states that because Bianco et al. discloses that a physician may enter one of multiple email addresses, and this selection of which email address to enter into the Bianco et al. system "is a user choice made to define the preferred mode of communication as the physician sees fit." (*See* November 6, 2006 Office Action, p. 17).

This is wholly different from defining a "preferred mode of communications" as disclosed in the instant application. For example, the specification in the description of a preferred embodiment indicates that the physician can, through the web page, select a preference for communication as fax, pager, and/or email. (*See* Specification, p. 20). Further, Figure 7B shows a web page of a preferred embodiment with checkboxes for "fax," "pager," and "email." (*See* Specification, Fig. 7B). The selection of a preferred mode of communications as described in the context of the claimed invention therefore relates to a selection between one or more different possible modes of communication via the website, not merely a physician contemplating which email address to input into the system. The examiner has provided no evidence that one of ordinary skill in the art at the time of filing would interpret Bianco et al. in the unnatural and strained way suggested by examiner.

The examiner's further contentions regarding Bianco et al. fare no better. For example, the examiner contends that "Bianco et al. disclose the use of multiple communication hardware configurations," which therefore "enables a physician entering a phone number could [sic] set a preference by inserting a phone number that accesses a beeper," and, "[l]ike with email, it is the physician's choice as to which phone number to enter into the data field thereby creating an opportunity for the physician to 'set a preference.'" (*See* November 6, 2006 Office Action, p. 18). This reading of the Bianco et al. teachings is implausible for the same reasons described above in the context of the examiner's hypothetical email example: it simply finds no support in the disclosure of Bianco et al. Examiner is simply inventing additional disclosure to fill the gaps between the element claimed and the Bianco et al. disclosure.

Examiner's final example is simply speculation that is wholly unsupported by Bianco et al. Examiner states that because Bianco et al. has a "General Comments" field in one figure, this somehow "provides opportunity for the physician to provide additional instructions," and this "present[s] another opportunity for a physician to set a communication preference." (*See* November 6, 2006 Office Action, p. 18). This is the most egregious

example of the examiner inventing disclosure that is not present in Bianco et al. Bianco's description of Figure 24C is as follows:

> Moreover, the physician can submit his/her practice information utilizing the practice information form **256** as shown in **FIG. 24C** which allows entry of various information **258** regarding the physician's practice.

Bianco et al., p. 12, ¶ 0132. Nowhere does Bianco et al. even suggest that the information placed in this "general comments" field can include communication preferences. The fact that it is theoretically possible for such information to be entered does not mean that Bianco teaches this claim element. If this were the case, the fact that a space for "general information" exists in Bianco et al. would then anticipate every patent application filed after Bianco et al., because the claimed inventions could theoretically be disclosed in the "general comments" field of Bianco et al. Such a position is clearly ridiculous.

Accordingly, Bianco et al. does not teach or suggest the "communication preference" limitation in each of independent claims 1, 18, and 25 (and dependent claims 2-3, 5-17, and 20-23 depending therefrom). As a result, the rejection of each of these claims is improper and should be reversed, and all currently-pending claims are in condition for allowance.

B. Claims 1-3, 5-18, and 20-23 were improperly rejected under 35 U.S.C. § 103(a) because the portions of the Kiselik reference relied upon by the examiner are not supported by the priority document, and therefore those portions of Kiselik are not legal prior art to applicant under § 102(e)

The examiner has rejected independent claims 1 and 18 (and dependent claims 2-3, 5-17, and 20-23 depending therefrom) in part because "Kiselik discloses receiving a peer rating from the first health care provider of the second health care provider." (November 6, 2006 Office Action, p. 7). Applicant is entitled to the priority date of November 6, 2000, based on the filing date of his provisional patent application. Kiselik (US 2001/0034631), however, has a filing date of January 19, 2001. Kiselik is a continuation-in-part of application No. 09/489,233, filed on January 21, 2000, however under MPEP §§ 706.02(f)(1) and 2136.03(IV), Kiselik is only effective prior art as of January 21, 2000 to the extent the parent

application supports the portions of Kiselik examiner uses to support the rejection. Thus, if the portions of Kiselik relied upon by examiner are not supported in the parent application, Kiselik is not prior art to the current application under § 102(e). The evidence shows this to be the case.

Here, the applicable portion of Kiselik relied upon by examiner is its disclosure of a "peer rating from the first health care provider of the second health care provider." Specifically, the examiner cites the abstract and paragraphs 0059 and 0072. Kiselik generally relates to a system for selection of parties to a transaction regarding goods or services, and mentions "rating" the parties to the transaction. *See* Publication No. US 2001/0034631 A1 (hereinafter "Kiselik published application"), abstract. The cited paragraphs specifically disclose that the method may be applied to a physician referral system, and that the two physicians involved in the referral rate each other after the referral is complete. *See* Kiselik published application, ¶¶ 0059, 0072.

However, an examination of the disclosure of Kiselik's priority document, application no. 09/765,511 reveals that paragraphs 0059 and 0072 do not appear therein. Further, unlike the abstract in the Kiselik published application cited by the examiner, the abstract in the priority document is limited to sales of goods and services, and nowhere suggests that the disclosure could be applied more broadly. In fact, the priority document contains no mention whatsoever of any application of the method disclosed in the context of health care in general, or patient referral systems in particular. As a result, the portions of Kiselik's published application relied upon by the examiner in the rejections appealed from are not supported by Kiselik's priority document. As a result, Kiselik is not prior art under § 102(e) as to applicant for the purposes cited by the examiner. *See* MPEP §§ 706.02(f)(1); 2136.03(IV). Therefore, all rejections based in whole or in part on Kiselik are improper and should be reversed, and claims 1-3, 5-18, and 20-23 are in condition for allowance.

C. Claims 1-3, 5-18, 20-23 and 25 were improperly rejected under 35 U.S.C. § 103(a) because the portions of the Filler reference relied upon by the examiner are not supported by the priority document, and therefore those portions of Filler are not legal prior art to applicant under § 102(e)

The examiner has rejected independent claims 1, 18 and 25 (and dependent claims 2-3, 5-17, and 20-23 depending therefrom) in part because of various disclosures found in Filler (US 2001/0051881). For example, the examiner cites Filler for notifying the referred health care provider (independent claims 1, 18, and 25) and the referring and referred health care providers having a registration with the web site (independent claims 1 and 25). Regarding claims 10, 13-14, and 25, the examiner also references Filler for its teachings regarding communications with insurance companies via the claimed system and method. (*See* November 6, 2006 Office Action, pp. 4, 10). Further, regarding claim 9, the examiner relies on Filler for its disclosure that "the request for patient consultation includes patient demographic data." (*See* November 6, 2006 Office Action, p. 10). Similarly, regarding claim 12, the examiner relies on Filler for its disclosure of "appointment preference information." (*See* November 6, 2006 Office Action, p. 10). However, much like the situation described above with Kiselik, Filler is not prior art to the instant application for the teachings cited by examiner.

As noted previously, applicant is entitled to the priority date of November 6, 2000, based on the filing date of his provisional patent application. Filler, however, has a filing date of December 22, 2000. Filler claims priority to a provisional filing, application No. 60/171,446, filed on December 22, 1999, however, as discussed previously, under MPEP §§ 706.02(f)(1) and 2136.03(IV), Filler is only effective prior art as of December 22, 1999 to the extent the provisional filing supports the portions of Filler the examiner uses to support the rejections. Thus, if the portions of Filler relied upon by the examiner are <u>not</u> supported in the provisional filing, Filler is not prior art to the current application under § 102(e). As with Kiselik above, the evidence shows this to be the case with Filler as well.

The examiner generally relies upon Filler for, among other things, "both the first health care provider and the second health care provider having a health care provider registration; and notifying the second health care provider of the request for a patient consultation." (November 9, 2006 Office Action, pp. 4, 6, 12). This is a required element in independent claims 1, 18, and 25, and the dependent claims depending therefrom. These aspects of Filler, however, are not supported in Filler's priority document. In fact, Filler's provisional filing is a four-page disclosure that only has scant information relating to few concepts described in Filler's published application. For example, Filler's priority document nowhere discloses or suggests that both the referring and the referred physician are registered with the website. To the contrary, the priority document states only that the referring physician is registered, and that the managing medical entity (MME) assigns the patient to a referred physician. (Provisional application, page 1). There is simply no mention that the referred physician is also registered, and in fact teaches the contrary. Thus, because Filler's priority document does not suggest or disclose this limitation, Filler is not effective prior art for this ground of rejection. *See* MPEP §§ 706.02(f)(1); 2136.03(IV).

Similarly, Filler's provisional does not disclose or suggest notifying the second health care provider of the request for a patient consultation. This element is required in independent claims 1 and 25, and the dependent claims depending therefrom. In fact, the provisional teaches the opposite, stating that "the managing medical entity (MME) then assigns the patient to a contracted imaging center, contacts the patient and instructs them on contacting the imaging center." (Provisional application, page 1 (emphasis added)). The contact described in Filler's priority document is between the MME, patient, and imaging center, not between the MME and the second health care provider. Thus, because Filler's priority document does not suggest or disclose this limitation, Filler is not effective prior art for this ground of rejection. *See* MPEP §§ 706.02(f)(1); 2136.03(IV).

Filler is also relied upon by the examiner is its disclosure of a request for patient consultation that includes patient demographic data in his rejection of claim 9. However, nowhere in Filler's provisional filing is there any reference to patient demographic data

whatsoever. (*See* Provisional application 60/171,446.) Because Filler's priority document does not disclose or suggest requests for consultation that include patient demographic data, Filler is not effective prior art for this ground of rejection. *See* MPEP §§ 706.02(f)(1); 2136.03(IV).

Filler is further relied upon by the examiner is its disclosure of various communications with insurance companies as claimed in claims 10, 13-14, and 25. As with the other aspects of Filler described above, Filler's provisional filing has no reference to any communication with insurance companies. *See* Provisional application 60/171,446. In fact, the word "insurance" is never used in Filler's priority document. Because Filler's priority document does not disclose or suggest any communication with insurance companies, Filler is not effective prior art for this ground of rejection. *See* MPEP §§ 706.02(f)(1); 2136.03(IV).

Filler is also relied upon by the examiner is its disclosure of "appointment preference information." As with the other elements of Filler, this aspect of Filler's published application is nowhere disclosed or suggested in Filler's provisional application. Because Filler's priority document does not disclose or suggest anything with regard to appointment preferences, Filler is not effective prior art for this ground of rejection. *See* MPEP §§ 706.02(f)(1); 2136.03(IV).

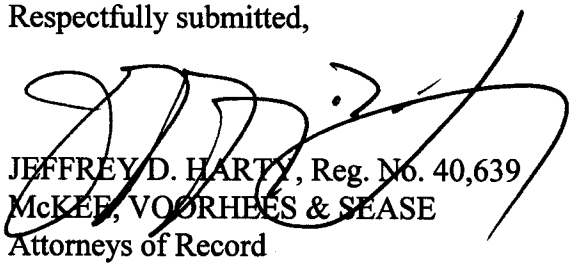
Accordingly, Filler is not effective prior art for the grounds of rejection asserted by the examiner in claims 1-3, 5-18, 20-23, and 25. As a result, these rejections are improper and should be reversed, and these claims are submitted to be in condition for allowance.

IX. CONCLUSION

As stated in the foregoing, the claims on appeal are not obvious under 35 U.S.C. § 103(a). In fact, every claim on appeal was erroneously rejected for at least two reasons as discussed above. Accordingly, it is respectfully submitted that the examiner's rejections should be reversed, and the pending claims are in condition for allowance.

Enclosed herein please find the Appeal Brief and required fee of $250. If this amount is not correct, please consider this a request to debit or credit Deposit Account No. 26-0084 accordingly.

Respectfully submitted,



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X. APPENDIX - CLAIMS

Claim 1 (Previously presented): A method of managing patient referrals, comprising:

providing a web site accessible to a plurality of health care providers;

receiving through the web site, a plurality of health care provider registrations each associated with a health care provider;

receiving a request for a patient consultation from a first health care provider to be performed by a second health care provider, both the first health care provider and the second health care provider having a health care provider registration;

notifying the second health care provider of the request for a patient consultation according to a preferred mode of communication setting set by the second health care provider on the web site; and

receiving a peer rating from the first health care provider of the second health care provider.

Claim 2 (Original): The method of claim 1 further comprising receiving a response from the second health care provider accepting or declining the request for a patient consultation.

Claim 3 (Original): The method of claim 2 further comprising scheduling a time for the patient consultation.

Claim 4 (Cancelled)

Claim 5 (Previously presented): The method of claim 1 wherein the peer rating is anonymous.

Claim 6 (Previously presented): The method of claim 1 wherein the peer rating is attributed to the first health care provider.

Claim 7 (Previously presented): The method of claim 1 further comprising providing the peer rating to the second health care provider.

Claim 8 (Original): The method of claim 1 further comprising providing a health care provider profile associated with a health care provider registration.

Claim 9 (Original): The method of claim 1 wherein the request for patient consultation includes patient demographic data.

Claim 10 (Original): The method of claim 1 wherein the request for patient consultation includes insurance information.

Claim 11 (Original): The method of claim 1 wherein the request for patient consultation includes patient contact information.

Claim 12 (Original): The method of claim 1 wherein the request for patient consultation includes appointment preference information.

Claim 13 (Original): The method of claim 1 further comprising providing information concerning the request for patient consultation to an insurer.

Claim 14 (Original): The method of claim 13 further comprising receiving notification of approval or denial from the insurer.

Claim 15 (Original): The method of claim 1 wherein the step of notifying is notifying via email.

Claim 1 (Original): The method of claim 1 wherein the step of notifying is notifying via fax.

Claim 17 (Original): The method of claim 1 wherein the step of notifying is notifying via paging.

Claim 18 (Previously presented): A system for managing patient referrals, comprising:
a web site accessible to a plurality of health care providers;
at least one registration web page within the web site to allow each of the plurality of health care providers to register to become registered health care providers;
an inbox within the web site associated with at least one of the registered health care providers and containing at least one request for a patient consult made to the at least one of the registered health care providers;
an outbox within the web site associated with the at least one of the registered health care providers and containing at least one request for a patient consult made by the at least one of the registered health care providers;
a peer review component for providing feedback related to a patient consult by a consulting health care provider from a referring health care provider;
a mode of communication preference set by a referring health care provider and provided to a consulting health care provider.

Claim 19 (Cancelled)

Claim 20 (Original): The system of claim 18 wherein the at least one registration web page includes a physician registration web page.

Claim 21 (Original): The system of claim 18 wherein the at least one registration web page includes a clinic registration web page.

Claim 22 (Original): The system of claim 18 wherein the at least one registration web page includes a department registration web page.

Claim 23 (Original): The system of claim 18 further comprising a patient registration web page.

Claim 24 (Cancelled)

Claim 25 (Previously presented): A method of managing patient referrals, comprising:

providing a web site accessible to a plurality of health care providers, the plurality of health care providers including a referring physician and a consulting physician;

receiving a request on the web site from the referring physician for a patient consultation to be performed by the consulting physician on a patient;

notifying the consulting physician of the request for a patient consultation;

requesting an authorization number for the patient consultation from an insurer providing insurance to the patient;

wherein the step of notifying the consulting physician is notifying the consulting physician according to a preferred mode of communications setting set by the consulting physician on the web site.

Claims 26-27 (Cancelled)

XI. EVIDENCE APPENDIX

None

XII. RELATED PROCEEDING APPENDIX

None